

## I. Introduction

Each of the independent claims (Claims 1, 5, and 9) recites a telephone network element. These claims were rejected under 35 U.S.C. § 103(a). Claim 1 was rejected as being unpatentable over U.S. Pat. No. 6,236,716 ("Marcus") in view of U.S. Pat. No. 5,953,401 ("Caveney"). Claims 5 and 9 were rejected as being unpatentable over Marcus in view of Caveney and U.S. Pat. No. 5,668,862 ("Bannister"). Applicants respectfully request reconsideration and withdrawal of the rejections because the proposed combinations do not teach a telephone network element that provides a menu to a caller to allow the caller to route their telephone call to one of a plurality of external destinations, as recited in each of the independent claims.

## II. The Proposed Combinations Do Not Render the Independent Claims Unpatentable

Each of the independent claims is directed to providing a family telecommunications service that facilitates access to a family residence and locations of family members other than the family residence. Claims 1, 5, and 9 all recite a telephone network element that provides a menu within a telephone call, and neither Marcus nor Caveney discloses or suggests this element. In contrast, both Marcus and Caveney teach telecommunications systems that are limited to routing calls within an *internal telecommunications system* located on a single premises where a telephone network element is not present.

Marcus discloses a system and method for operating an automatic call parking and paging within an internal phone system. In Marcus, a caller places a telephone call to a main number of an internal telecommunications system. The system receives the call and provides the caller with a menu or some other type of directory to choose an intended recipient within the internal telecommunication system. After the caller chooses the intended recipient, the system automatically places the caller on hold (parks the call). The system then pages the intended recipient of the telephone call, and if the intended recipient responds to the page, routes the telephone call to the intended recipient. Critically, the system of Marcus is limited to an internal telecommunication system. As stated in the specification, the system is "located within

a business premises to provide communication functions for a plurality of extensions 134-142 within the business premises.” (Col 5, lines 51-53). ***The system in Marcus does not contain a telephone network element, as recited in Claim 1.***

***Like Marcus, Caveney does not teach a telephone network element, as recited in Claim 1.*** Caveney discloses a system and method for completing a telephone call to “an internal destination without operator assistance and without receiving a generated voice message.” (Abstract; Col 2, lines 1-2). In Caveney, a caller places a telephone call to a main number of an internal telecommunication system. The system receives the call, and the caller may dial a number such as an extension number or do nothing. If the caller dials an extension number, the telephone call is routed to the intended recipient. During this time, if the system receives a dual-tone multi-frequency trigger, the system creates a new dial tone where the caller may input a new extension number. If the caller dials nothing after the system receives the call, the telephone call is automatically routed to a predetermined number.

Because neither Marcus nor Caveney teach a telephone network element providing a menu, as recited in Claims 1, 5, and 9, the proposed combination necessarily does not teach the recited telephone network element. When combined, Marcus and Caveney merely provide an internal telecommunications system that routes a telephone call to an extension or automatically parks a call and pages the intended recipient without operator assistance and without receiving a generated voice message. Both connecting a caller to an extension, and the automatic call parking and paging is ***limited to extensions within an internal telecommunications system on a single premises***. The proposed combination does not disclose or suggest at least the limitation of Claim 1 of a telephone network element providing a menu within a telephone call to connect the caller to a plurality of external destinations such as a family residence, a first location of a first family member other than the family residence, and a second location of a second family member other than the family residence. Thus, the proposed combination of Marcus and Caveney does not render Claim 1, or any of the independent claims, unpatentable. Applicants respectfully request the withdrawal of the rejection to Claim 1 and any of its dependant claims under 35 U.S.C. § 103(a).

### **III. There is No Motivation to Modify the Proposed Combination to Include a Telephone Network Element**

Applicants submit that one skilled in the art would not have been motivated to modify the proposed combination of Marcus and Caveney to include a telephone network element. The purpose of Caveney is to provide a telecommunications system where a user can complete a call to an *internal destination* without operator assistance or a generated voice message. To modify Caveney to include a telephone network element providing a menu such as a generated voice message would change the principle operation of Caveney from an internally-based system.

### **IV. The Proposed Combination Does Not Have Components Located on the Public Switched Telephone Network**

Even if the term “telephone network element” is misinterpreted to read on the internal components taught in the proposed combination, new dependant Claims 15-17 are still allowable. Claims 15-17 recite that the telephone network element is in the public switched telephone network. As explained above, the proposed combination is *limited to extensions within an internal telecommunications system on a single premises*. A public switched telephone network may be defined as a collection of interconnected voice-oriented public telephone networks. The proposed combination does not disclose, or suggest, at least the limitation of Claims 15-17 of a telephone network element on a public switched telephone network providing a menu within a telephone call to connect the caller to a plurality of external locations. Thus, the proposed combination of Marcus and Caveney does not render Claims 15-17 unpatentable.

**V. The Addition of Bannister to the Proposed Combination Does Not Render the Independent Claims Unpatentable.**

Independent Claims 5 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Marcus in view of Caveney and Bannister. Each of the independent claims recites a telephone network element that provides a menu to a caller to allow the caller to route their telephone call to a plurality of external destinations. The combination of Marcus, Caveney, and Bannister does not teach at least this limitation.

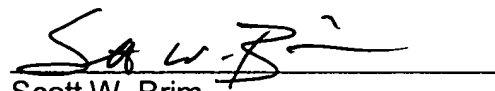
Bannister discloses a method for an intended recipient of a telephone call to screen incoming calls based on the role of the telephone number dialed by a caller. Generally, the caller places a telephone call to a particular telephone number associated with a role of an intended recipient, such as “private,” “business,” or “social” roles. For example, the intended recipient may provide one telephone number for “private” purposes. When a caller places a telephone call to the private telephone number, the service node takes control of the call and routes the telephone call to an alerting device, such as a cellular phone, identified by the profile of the subscriber. Critically, Bannister does not teach providing a menu to a caller to allow *the caller* to route their telephone call to different alerting devices. ***Therefore, like Marcus and Caveney, Bannister does not teach a telephone network element that provides a menu to a caller to allow the caller to route their call to a plurality of external destinations, as recited in Claims 5 and 9.***

When combined, Marcus, Caveney, and Bannister merely provide an internal telecommunications system that routes a telephone call to an extension or automatically parks a call and pages the intended recipient without operator assistance and without receiving a generated voice message wherein an intended recipient of a telephone call is able to screen incoming calls based on the role of the telephone number dialed by a caller. The proposed combination does not disclose, or suggest, at least the limitation of Claims 5 and 9 of a telephone network element that provides a menu to allow a caller to route their call to a plurality of external destinations. Thus, the proposed combination does not render Claims 5 and 9 unpatentable. Applicants respectfully request the withdrawal of the rejection to Claims 5 and 9, and any of their dependant claims under 35 U.S.C. § 103(a).

#### IV. CONCLUSION

In view of the foregoing remarks, Applicants submit that the pending claims are in condition for allowance. Reconsideration is therefore respectfully requested. If there are any questions concerning this Response, the Examiner is asked to phone the undersigned attorney at (312) 321-4200.

Respectfully submitted,



Scott W. Brim  
Registration No. 51,500  
Attorney for Applicants

BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, ILLINOIS 60610  
(312) 321-4200